

REMARKS

This is in response to the Office Action mailed May 31, 2006.

Claims 1, 3 through 6 and 12 through 17 are currently pending in the application.

Claims 2 and 18 through 23 have been canceled.

Claims 12 through 17 are withdrawn from consideration.

Claims 1 through 6 and 18 through 23 stand rejected. Applicant has amended claim 1, and respectfully request reconsideration of the application as amended herein.

Applicant notes the filing of an Information Disclosure Statement herein on May 23, 2006, and note that no copy of the PTO/SB/08A was returned with the outstanding Office Action. Applicant respectfully requests that the information cited on the PTO/SB/08A (which is the same as that of record to that date in the parent application hereto) be made of record herein.

35 U.S.C. § 112 Claim Rejections

Claims 18 through 23 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has canceled claims 18 through 23.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on Applicant's Admitted Prior Art

Claims 1 through 6 and 18 through 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Applicant's Admitted Prior Art (hereinafter referred to as "AAPA"). Applicant respectfully traverses this rejection, as hereinafter set forth.

Applicant asserts that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Brothers v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The

identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant asserts that the AAPA does not and cannot anticipate the claimed invention of presently amended independent claim 1 under 35 U.S.C. § 102 because the AAPA does not identically describe each and every element of the claimed invention in as complete detail as is contained in the claim. Applicant asserts that the AAPA does not identically describe the element of the claimed invention of presently amended independent claim 1 calling for “an interposer connected to the substrate, the interposer having a laser roughened surface increasing the surface area thereof to adhere mold material thereto in a molding operation” and “a portion of resist, contamination and oxidation on at least a portion of the surface of the substrate of semiconductive wafer material removed by laser etching of the resist, contamination, and oxidation from the surface of the substrate using a laser forming a portion of an automolding system prior to the encapsulation of a portion of the semiconductor device in the automolding system”. Applicant asserts that the AAPA does not describe any such elements of the claimed invention of presently amended independent claim 1. Accordingly, presently amended independent claim 1 is allowable as well as

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on AAPA in view of U.S. Patent 6,031,249 to Yamazaki et al. in view of U.S Patent Publication No. 2002/0070440 to Aiba et al., and in view of Japanese Patent No. 11006073 to Miyashita

Claims 1 through 6 and 18 through 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of Yamazaki et al. (U.S. Patent 6,031,249) in view of Aiba et al. (U.S. Patent Publication No. 2002/0070440), and in view of Miyashita (Japanese Patent No. 11006073). Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must

be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Applicant asserts that the proposed combination of the cited prior art does not establish a *prima facie case* of obviousness under 35 U.S.C. § 103 regarding the claimed invention of independent claim 1 because the proposed combination of the cited prior art is not prior art to the claimed invention. Applicant asserts that the Aiba et al. reference is not prior art to the claimed invention of the present application. Applicant asserts that the effective filing date of the present application is May 21, 2001. The date the Aiba et al. reference is available for prior art purposes is June 13, 2002, the publication date of the reference. Applicant asserts that the Aiba et al. reference is not available as prior art based upon its May 30, 2001, the filing date thereof which is still after the effective filing date of May 21, 2001, of the present application. Therefore, the Aiba et al. reference is not prior art to the claimed invention of the present application and any rejection of the claimed invention of the present application based on the use of the Aiba et al. reference is improper. Accordingly, presently amended independent claim 1 is allowable as well as the dependent claims therefrom.

ENTRY OF AMENDMENTS

The amendments to claim 1 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application to clearly comply with the provisions of 35 U.S.C. § 132. Further, the amendments do not raise new issues or require a further search.

CONCLUSION

Claims 1 and 3 through 6 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,



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Date: August 30, 2006
JRD/sfc:lmh
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